

REMARKS

Claims 6, 7, 12, 18, 19, 23, 27, and 35 have been amended. Claims 1-5, 13-17, and 33-34 have been canceled. Claims 6-12, 18-32, and 35 remain in the application. Reexamination and reconsideration of the application as amended are respectfully requested. The Examiner's comments are shown in bold.

Claim Rejections - 35 USC § 101

Claims 1-35 are rejected [less than] 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The non-statutory subject matter of claims 1-35 is directed to providing living subject matters (human beings) for a game

On 10/29/03 the Examiner, Supervisor Tom Hughes, and Ted Masters discussed this issue. It was resolved that reciting the players in the preamble, and deleting "providing players" language in the body of the claims would correct the deficiency. As such, Claims 6, 7, 12, 18, 19, 23, 27, and 35 have been so amended.

Claim Rejections - 35 USC § 102

Claims 1, 7, 13, 23-24, and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Stephens '414.

Regarding Claims 1 and 13:

The Applicant has canceled Claims 1 and 13.

Regarding Claim 7:

The Applicant respectfully requests that the Examiner revisit the rejection of Claim 7. Claim 7 recites a game of chess between three players, using four sets of chess pieces, wherein one set of chess pieces is a common set. To that end, Claim 7 contains the following limitations:

said additional rules of play including:

- designating said set of chess pieces disposed on a fourth side of said playing area as common pieces which may be moved by any of said three players;*
- said three players and said common pieces sequentially taking turns moving;*
- when it is said common pieces turn to move, said three players sequentially taking turns moving said common pieces; and,*

Stephens does not teach or suggest (1) designating a set of chess pieces as common pieces which may be moved by any of the three players, and (2) the three players sequentially taking turns to move the common pieces.

Therefore in accordance with MPEP 2131 (all claim elements not taught), the Applicant submits that Claim 7 distinguishes over Stephens, and should be allowable.

Regarding Claim 23:

The Applicant respectfully requests that the Examiner revisit the rejection of Claim 23. Claim 23 as amended. As amended, Claim 23 contains the following limitations:

(2) providing two, and only two, sets of chess pieces, each said set of chess pieces including:

16 pawns;
four rooks;
four knights;
four bishops;
one king; and,
one queen;

It is noted that the claimed sets of chess pieces are unique in that they contain double the number of pawns, rooks, knights, and bishops, but only one king and one queen (refer also to FIG. 7).

Stephens does not teach or suggest such a limitation. Stephens teaches four sets of conventional chess pieces.

Therefore in accordance with MPEP 2131 (all claim elements not taught), the Applicant submits that Claim 23 distinguishes over Stephens, and should be allowable.

Regarding Claim 24:

Claim 24 depends from allowable Claim23, and is therefore also allowable.

Regarding Claim 27:

The Applicant respectfully requests that the Examiner revisit the rejection of Claim 27. Claim 27 recites a game of chess in which two players play, each player having two sets of chess pieces (refer to FIG. 8). As such, Claim 27 as amended contains the limitations:

A method for two players, and only two players, to play a modified game of chess, comprising:

two sets of said chess pieces belonging to one said player and another two sets of said chess pieces belonging to said other player;. . .

- the game ending when both of a player's kings have been put into checkmate;

Stephens does not teach or suggest the above cited limitations. Stephens teaches a four player game in which to teams of two players compete against each other.

Therefore in accordance with MPEP 2131 (all claim elements not taught), the Applicant submits that Claim 27 distinguishes over Stephens, and should be allowable.

Regarding Claim 28:

Claim 28 depends from allowable Claim27, and is therefore also allowable.

**Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Doug Vogel.
(Vogel)**

The Applicant has canceled Claim 33.

Claim Rejections - 35 USC § 103

Claims 2, 4, 8, 10, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens '414 in view of McLoy '602.

Regarding Claims 2, 4, 14, and 16:

The Applicant has canceled these claims.

Regarding Claim 8:

Claim 8 depends from allowable Claim 7 (see above) and is therefore also allowable.

Regarding Claim 10:

Claim 10 depends from allowable Claim 7 (see above) and is therefore also allowable.

Claims 3, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens '414 in view of Adams '666 and Wearley '762.

Regarding Claims 3 and 15:

The Applicant has canceled these claims.

Regarding Claim 9:

Claim 9 depends from allowable Claim 7 (see above) and is therefore also allowable.

Claims 5, 11, 17, 25, 31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens '414 in view of Nebermann.

Regarding Claims 5 and 17:

The Applicant has canceled these claims.

Regarding Claim 11:

Claim 11 depends from allowable Claim 7 (see above) and is therefore also allowable.

Regarding Claim 25:

Claim 25 depends from allowable Claim 23 (see above) and is therefore also allowable.

Regarding Claim 31:

Claim 31 depends from allowable Claim 27 (see above) and is therefore also allowable.

Regarding Claim 34:

The Applicant has canceled Claim 34.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doug Vogel in view of Nebermann.

Regarding Claim 34:

The Applicant has canceled Claim 34.

Allowable Subject Matter

Claims 6, 12, 18, 26, 29-30, 32, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 6, 18, and 35 have been rewritten in independent form herein. Claims 12, 26, 29-30, and 32 remain in the application. Pending resolution of this amendment, some of these claims may be subsequently rewritten in independent form to place the application in condition for allowance.

Claims not Cited in Office Action

Claims 19-22 were not cited in the subject Office Action.

Regarding Claim 19:

Claim 19 recites a method for two players to play a game of chess, wherein each player has a set of chess pieces, and further including two common sets of chess pieces. The two players take turns moving the common sets of chess pieces. Claim 19 as amended contains the following limitations:

- *additional rules of play which modify said conventional rules of chess play, said additional rules of play including:*
 - *designating said sets of chess pieces disposed on two unoccupied sides of said playing area as common pieces which may be moved by both of said two players;*
 - *said two players and said two common pieces sequentially taking turns moving;*
 - *when it is each of said common pieces turn to move, said two players sequentially taking turns moving said common pieces; and,*

None of the cited prior art references teach or suggest such limitations. Therefore the Applicant submits that Claim 19 should be allowable.

Regarding Claim 20:

Claim 20 depends from allowable Claim 19 and is therefore also allowable.

Regarding Claim 21:

Claim 21 depends from allowable Claim 19 and is therefore also allowable.

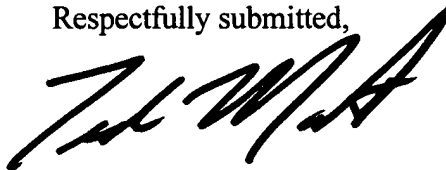
Regarding Claim 22:

Claim 22 depends from allowable Claim 19 and is therefore also allowable. Also, Claim 22 contains the same allowable language found in allowable Claims 6.

Form PTO-948 was not included in the Office Action, therefore the Applicant assumes that the drawings are acceptable.

In view of the above, Applicant respectfully requests allowance of all the claims remaining in the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Ted Masters", written in a cursive style.

Ted Masters Reg. 36,209
23344 8th St
Newhall, CA 91321

(661) 255-2333